

## REMARKS

Claims 1-10 are pending in this application. Claims 1, 2 and 8 have been rejected. Claims 1 and 8 have been amended.

The Examiner has indicated in the present Office Action that claims 3-7, 9 and 10 are "objected to as being dependent upon a rejected based, but would be allowable if rewritten in independent form." Applicants note that claims 3-7, 9 and 10 are already in independent form (as re-written in the Amendment mailed on November 26, 2002), and the Examiner has previously allowed claims 3-7, 9 and 10 in the Advisory Action mailed on February 13, 2003.

Claims 1, 2 and 8 are rejected under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent 5,594,735 to Sigl ("Sigl"). Applicants respectfully submit that the rejection should be reversed for the following reasons.

Initially, Applicants note that the present Office Action was issued in response to the Board of Appeals' "Remand to the Examiner" mailed on February 19, 2004. In the Remand, the Board specifically indicated that "given the detailed nature of the appellants' arguments in the reply briefs, we request that the examiner provide a response on the record to the arguments raised by appellants in the reply briefs," and that a "supplemental examiner's answer clarifying the issues . . . will be necessary." (Remand, pp. 5-6). However, Applicants note that the Examiner has not provided "a response on the record to the arguments raised by appellants in the reply briefs," as requested by the Board. Instead, the Examiner has issued the present Office Action rejecting claims 1, 2 and 8, which Office Action is substantially identical to the Final Office Action mailed on September 20, 2002, with the following differences: a) the present Office Action rejects claims 1, 2 and 8 as being anticipated by Sigl, whereas the previous Final Office Action rejected claims 1, 2 and 8 as being rendered obvious by Sigl; b) regarding claims 1 and 8, the Examiner provides in the present Office Action the

additional comment that “[t]he vehicle speed exceeds preset limit after an intervention in an engine output (i.e. fuel cut off) this detects when the car goes downhill (column 3, lines 32-36) manipulated variables are applying the brakes (col. 3, ln 46-49, 55-59)”; and c) regarding claim 2, the Examiner provides in the present Office Action the statement that “Sigl teaches at least that one manipulated variable is calculated only when one switch is activated (when it turns on the cruise control - column 3).” Applicants will address these issues in detail below.

To anticipate a claim, each and every element as set forth in the claim must be found in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of Calif.*, 814 F.2d 628, 631, 2 U.S.P.Q.2d 1051, 1053 (Fed. Cir. 1987). Furthermore, “[t]he identical invention must be shown in as complete detail as is contained in the . . . claim.” *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 U.S.P.Q.2d 1913, 1920 (Fed. Cir. 1989). That is, the prior art must describe the elements arranged as required by the claims. *In re Bond*, 910 F.2d 831, 15 U.S.P.Q.2d 1566 (Fed. Cir. 1990). Additionally, not only must each of the claim limitations be identically disclosed, an **anticipatory reference must also enable** a person having ordinary skill in the art to practice the claimed invention, namely the inventions of the rejected claims, as discussed above. *See, Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986). Furthermore, to the extent the anticipation is based on the doctrine of inherence, the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; *see also, Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic **can occur** in the prior art does not establish the inherence of that result or characteristic.

Claim 1, as amended, recites “[a] method for controlling a vehicle

comprising . . . ***detecting whether the vehicle is traveling on a descent, by using an arrangement for detecting the descent of the vehicle.***” Claim 8 similarly recites “an arrangement for detecting the descent of the vehicle.” As exhaustively explained in the preceding prosecution leading up to this Response, Applicants respectfully submit that the claimed limitation “detecting” necessarily involves affirmative **monitoring** and **recognition** of an occurrence of a condition, **not merely the occurrence of a condition**, particularly since claim 1 and 8 both recite “an arrangement for detecting the descent of the vehicle.” In this regard, the Applicants’ specification clearly indicate that “***detecting whether the vehicle is traveling on a descent***” is accomplished by utilizing a ***vehicle tilt sensor or a computation*** based on “the rate of change of acceleration, the offset acceleration, which is caused by, among other things, the change in vehicle position, and . . . the wheel brake pressure.” (Specification, p. 4, l. 1-3 and 11-14). The Specification further indicates that “[i]f descent is detected, the controller is activated.” (P. 5, l. 9). Accordingly, it is absolutely clear that the claimed limitation “detecting” necessarily involves affirmative **monitoring** and **recognition** of an occurrence of a condition, **not merely the occurrence of a condition**.

In contrast to the claimed invention, the Sigl reference merely mentions ***an occurrence of a vehicle traveling on a descent***, but simply does not perform any affirmative **detection** of whether the vehicle is traveling on a descent, particularly since Sigl does not even discuss **any arrangement** configured to determine whether the vehicle is traveling on a descent, as recited in claims 1 and 8. Accordingly, it is quite clear that Sigl definitely does not enable a person having ordinary skill in the art to practice the claimed invention including “***detecting whether the vehicle is traveling on a descent, by using an arrangement for detecting the descent of the vehicle,***” which is required for anticipation. See, *Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986).

To the extent the Examiner is contending that the cited sections of

Sigl inherently teach the claimed limitation of “**detecting whether the vehicle is traveling on a descent, by using an arrangement for detecting the descent of the vehicle,**” the Examiner must provide a “basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art,” not merely that the claimed limitation **can occur** in the prior art. Initially, Applicants note that Sigl simply does not discuss any arrangement configured to ascertain whether a vehicle is traveling on a descent, and there is no reasonable interpretation of Sigl that will support the conclusion that Sigl **inherently teaches** any arrangement configured to ascertain whether a vehicle is traveling on a descent. Furthermore, the section of Sigl relied upon by the Examiner as teaching **detection** of a descent actually indicates that “when driving on downhill grades, it **can happen** that the speed is no longer able to be maintained through an intervention in the engine output.” (Col. 3, lines 32-35). Accordingly, the Sigl reference merely lists a downhill grade as an *example* of a situation in which the adjusted speed **can be** exceeded, i.e., an **occurrence**, but the Sigl reference simply does not teach or suggest that the adjusted speed is **necessarily always exceeded** on downhill grades. Accordingly, Sigl does not support the Examiner’s interpretation that a passive **occurrence** (i.e., exceeding of the adjusted speed) corresponding to the presence of a downhill grade is **inherently** equivalent to the claimed limitation of “**detecting whether the vehicle is traveling on a descent, by using an arrangement for detecting the descent of the vehicle,**” since nothing in Sigl indicates that the passive occurrence **necessarily always occurs**. Instead, Sigl merely describes the effect of driving on downhill grades. For the foregoing reasons, the Sigl reference cannot anticipate claims 1 and 8 of the present invention.

In addition to the above-noted distinction, Sigl also fails to teach or suggest the claimed feature of “calculating at least one manipulated variable based on the actual speed and the setpoint speed **only when the vehicle is detected as traveling on the descent,**” as recited in claim 1, and as similarly recited in amended claim 8. There is no teaching or suggestion in Sigl with respect to calculating a

manipulated variable *only* when a descent is detected. In fact, as noted above, there is no teaching in Sigl with respect to detecting a descent, let alone teaching an arrangement configured for such detection, so it is impossible for Sigl to suggest calculating a variable *only* when a descent is detected. Therefore, Sigl fails to anticipate claims 1 and 8 for this additional reason.

Claim 2 depends from claim 1, and therefore claim 2 is allowable for at least the same reasons that claim 1 is allowable. Independent of this reason, claim 2 is further distinguishable from Sigl based on the limitation that “the at least one manipulated variable is calculated ***only when*** one of a switch and a button is activated.” While the Examiner contends that turning on the cruise control triggers the manipulated variable (alleged by the Examiner to be the **application of brakes**) to be calculated, nothing in Sigl suggests that the manipulated variable is calculated ***only when*** the cruise control is turned on. For at least this additional reason, claim 2 is not anticipated by Sigl.

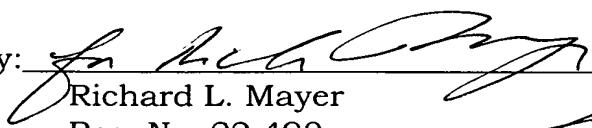
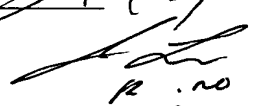
#### CONCLUSION

For the foregoing reasons, it is respectfully submitted that the rejection of claims 1, 2 and 8 should be withdrawn.

Respectfully submitted,

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